

B. Remarks

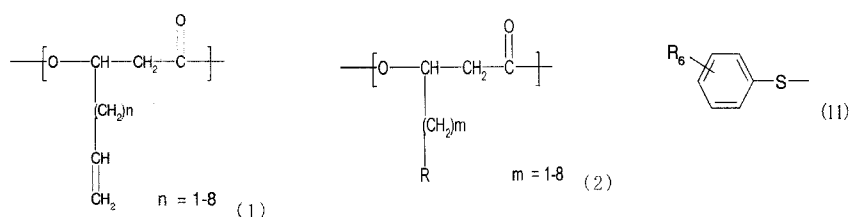
The claims are 1-29, with claims 1-3 being addressed herein and claims 4-29 having been withdrawn from consideration as being drawn to non-elected subject matter; claim 1 is the sole independent claim under consideration at this time. Reconsideration of the pending claims is respectfully requested.

Claims 1-3 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to satisfy the enablement requirement. More specifically, the Examiner has alleged that while the specification is enabling for the examples of copolymers having monomeric units, the specification is not enabling for the claimed structures having specific units in specific ratios; the Examiner further alleged that the Applicants have failed to provide evidence of isolating a single product having a specific structure and properties, but only mixtures of polymers having monomeric units having an average molecular weight for the mixture of different polymers in the mixture. Applicants respectfully traverse this rejection.

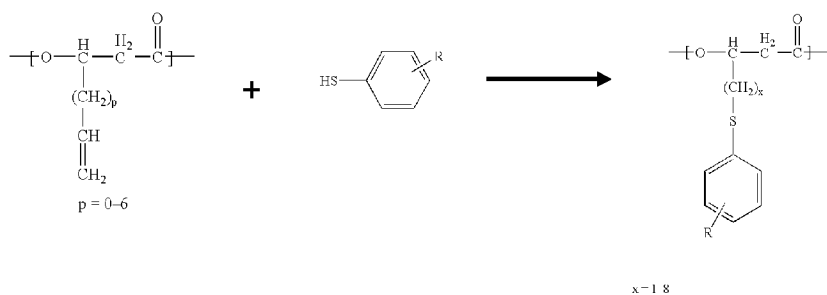
The specification sets forth a process for forming the claimed copolymers, including the disclosure of the microorganisms used to produce them, the media and the substrate. Applicants submit that once the monomer units are produced, a person skilled in the art would readily know how to polymerize these monomers to form copolymers. What is more, there is no requirement for a patent application to provide an example of isolating a claimed product. The enablement requirement is satisfied if a person skilled in the art would be able to practice the invention without undue experimentation based not only on the disclosure in the specification but the knowledge in the art. Applicants submit that the disclosure of a process of forming the monomers of the copolymer is sufficient for a skilled artisan to form the claimed copolymer without undue experimentation. For these reasons, Applicants respectfully request withdrawal of the §112 rejection.

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Imamura (U.S. Patent No. 7,045,321). Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Imamura alone or in view of Kenmoku (U.S. Patent No. 6,869,782). Applicants respectfully traverse these rejections.

Simply put, Imamura does not disclose a copolymer comprising the monomer units as recited in the present claims. The structure included in the polyhydroxyalkanoate copolymer of claim 1 (and dependent claims 2 and 3) of the subject application is constituted of monomer units (1) and (2), where R is represented by formula (11):



On the other hand, Imamura discloses the following:



Imamura actually describes a method in which one of the monomer units within the scope of a unit recited in current claim 1 is formed from another such monomer unit. However, Imamura in no way discloses or suggests the polyhydroxyalkanoate copolymer of the subject application. In other words, Imamura uses one monomer that is used in the present invention to make another monomer that is used in the present invention, but does not disclose or suggest the combination of those two monomers to make the copolymer of the present invention. Kenmoku does not remedy the deficiencies of Imamura. For at least these reasons, Applicants respectfully request withdrawal of the §102 and §103 rejections.

In view of the foregoing remarks, favorable reconsideration and passage to issue of the present claims is respectfully requested. Should the Examiner believe that issues remain outstanding, the Examiner is respectfully requested to contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

/Elizabeth F. Holowacz/
Elizabeth F. Holowacz
Attorney for Applicants
Registration No. 42,667

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200